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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,628	03/29/2001	Kenjiro Morimoto	K6510.0056/P056	4427

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EXAMINER

PHAN, TAM T

ART UNIT	PAPER NUMBER
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2144

DATE MAILED: 07/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/819,628

Applicant(s)

MORIMOTO, KENJIRO

Examiner

Tam (Jenny) Phan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2004.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-19 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This application has been examined. Claims 1-19 are presented for examination.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.
3. The effective filing date for the subject matter defined in the pending claims which has support in JP 2000-095929 in this application is 03/30/2000. Any new subject matter defined in the claims not previously disclosed in JP 2000-095929, is entitled to the effective filing date of 03/29/2001.

Information Disclosure Statement

4. An initialed and dated copy of Applicant's IDS form 1449, Paper No. 5, is attached to the instant Office action.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 16 and 17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter of a "program per se". Programs per se are not patentable.
7. For examining purposes, "a program" in claim 16 and 17 will read as "a computer readable medium storing a program" to allow these claims to be statutory.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

9. Claims 1-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Kume (U.S. Patent Number 6,203,433).

10. Regarding claim 1, Kume disclosed an online organizing method comprising the steps of: searching personal information of participants of a plurality of terminals connected to a network; selecting the participants, who are compatible with one another, based on the personal information of the participants to organize selected participants; and sharing information by the terminals of the organized participants; and transmitting to the respective terminals control information for carrying out a specific task (Abstract, Figures 1, 3-6, 8, 11, column 2 lines 4-45, column 3 lines 1-44, column 5 lines 48-55, column 8 lines 13-25, column 22 lines 1-38).

11. Regarding claim 2, Kume disclosed an online organizing method wherein for collecting on line the information for the organization from the terminals connected to the network, the participants input information by selecting items displayed on the screens to input the information (Abstract, Figures 1 & 3, column 5 lines 48-56, column 16 lines 1-21, column 22 lines 1-8).

12. Regarding claim 3, Kume disclosed an online organizing method comprising the steps of: searching personal information of participants of a plurality of terminals connected to a network; selecting the participants, who are compatible with one another, based on the personal

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information of the participants to organize the selected participants; sharing information by the terminals of the organized participants; and transmitting control information for starting a program to be carried out on the terminals from an intervening stage of the program (Abstract, Figures 1, 3-6, 8, 11, column 5 lines 48-55, column 8 lines 13-25, column 16 lines 1-21, column 17 lines 8-22, column 22 lines 1-38).

13. Regarding claim 4, Kume disclosed an online organizing method wherein said program is an online game, and said intervening stage is one of stages of the online game (column 1 lines 12-24, column 2 lines 16-26, column 15 lines 19-28, column 16 lines 1-21).

14. Regarding claim 5, Kume disclosed a server comprising: organizing means for, based on personal information of participants of a plurality of terminals connected to a network, selecting the participants, who are compatible with one another, to organize the selected participants; and information sharing means for interconnecting the terminals of the organized participants to share information (Abstract, Figures 1, 3-6, column 3 lines 21-44, column 5 line 51-column 5 line 6, column 9 lines 21-28).

15. Regarding claim 6, Kume disclosed a server wherein said participants organized by the organizing means are supplied as they are to said information sharing means (Abstract, column 2 lines 16-45, column 5 lines 48-55, column 8 lines 13-25).

16. Regarding claim 7, Kume disclosed a server wherein said server transmits control information for carrying out a specific task to the terminals of the participants organized by the organizing means (Figures 1, 3-6, column 2 lines 27-45, column 3 lines 34-44, column 5 lines 3-6, column 9 line 60-column 10 line 8).

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17. Regarding claim 8, Kume disclosed a server wherein said specific task is a task for starting a program to be carried out on said plurality of terminals from an intervening stage of the program (Abstract, column 2 lines 16-45, column 4 line 51-column 5 line 6, column 16 lines 1-21, column 17 lines 8-22).

18. Regarding claim 9, Kume disclosed a server wherein said program is an online game, and said intervening stage is one of stages of the online game (column 1 lines 12-24, column 2 lines 16-26, column 15 lines 19-28, column 16 lines 1-21).

19. Regarding claim 10, Kume disclosed a terminal device to be connected to the server comprising: external memory means for storing personal information of a participant, when the terminal device is connected to the server, the personal information stored in the external memory means is uploaded to the server (column 21 lines 62-64).

20. Regarding claim 11, Kume disclosed an external memory means provided in a terminal device and storing the personal information of the users (column 21 lines 62-64).

21. Regarding claim 12, Kume disclosed a terminal device for a network system in which a plurality of the terminal devices are connected to a server, said terminal device transmitting personal information of a user to the server; sharing information through the server among the rest terminal devices organized by the server; and cooperating with the rest terminal devices to carry out a specific task (Abstract, Figures 1, 3-6, column 3 lines 21-44, column 5 line 51-column 5 line 6, column 9 lines 21-28).

22. Regarding claim 13, Kume disclosed a terminal device wherein said specific task is a task for starting a program to be carried out by said plurality of the terminal devices from an

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intervening stage of the program (Abstract, column 2 lines 16-45, column 4 line 51-column 5 line 6, column 16 lines 1-21, column 17 lines 8-22).

23. Regarding claim 14, Kume disclosed a terminal device wherein said program is an online game, and said intervening stage is one of stages of the online game (column 1 lines 12-24, column 2 lines 16-26, column 15 lines 19-28, column 16 lines 1-21).

24. Regarding claim 15, Kume disclosed a task carrying out method in which terminal devices connected to a server, comprising the steps of: transmitting personal information of the users of the terminal devices to the server; sharing information through the server among the rest terminal devices organized by the server; and cooperating with the rest terminal devices to carry out a specific task (Abstract, Figures 1, 3-6, column 3 lines 21-44, column 5 line 51-column 5 line 6, column 9 lines 21-28).

25. Regarding claim 16 and 18, Kume disclosed a computer readable medium storing a program for a server comprising the steps of: searching personal information of the participants of a plurality of terminals connected to a network; selecting the participants, who are compatible with one another, based on the personal information of the participants; sharing information among the terminals of the organized participants; and transmitting control information for carrying out a specific task (Abstract, Figures 1, 3-6, column 3 lines 21-44, column 5 line 51-column 5 line 6, column 9 lines 21-28, column 22 lines 19-37).

26. Regarding claim 17 and 19, Kume disclosed a computer readable medium storing a program for a terminal device comprising the steps of: transmitting to a server personal information of users; sharing information through the server among the rest terminal devices organized by the server; and cooperating with the rest terminal devices to carry out a specific

task (Abstract, Figures 1, 3-6, column 3 lines 21-44, column 5 line 51-column 5 line 6, column 9 lines 21-28, column 22 lines 19-37).

27. Since all the limitations of the claimed invention were disclosed by Kume, claims 1-19 are rejected.

28. Claims 1-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Sparks, II (U.S. Patent Number 6,352,479), hereinafter referred to as Sparks.

29. Regarding claim 1, Sparks disclosed an online organizing method comprising the steps of: searching personal information of participants of a plurality of terminals connected to a network; selecting the participants, who are compatible with one another, based on the personal information of the participants to organize selected participants; and sharing information by the terminals of the organized participants; and transmitting to the respective terminals control information for carrying out a specific task (Abstract, Figures 5A-6B, 12, column 5 lines 5-25, column 6 lines 18-33, column 7 lines 22-34).

30. Regarding claim 2, Sparks disclosed an online organizing method wherein for collecting on line the information for the organization from the terminals connected to the network, the participants input information by selecting items displayed on the screens to input the information (column 5 lines 5-26).

31. Regarding claim 3, Sparks disclosed an online organizing method comprising the steps of: searching personal information of participants of a plurality of terminals connected to a network; selecting the participants, who are compatible with one another, based on the personal information of the participants to organize the selected participants; sharing information by the

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terminals of the organized participants; and transmitting control information for starting a program to be carried out on the terminals from an intervening stage of the program (Abstract, Figures 5A-6B, 12, column 5 lines 5-25, column 6 lines 18-33, column 7 lines 22-34).

32. Regarding claim 4, Sparks disclosed an online organizing method wherein said program is an online game, and said intervening stage is one of stages of the online game (column 1 lines 37-49, column 6 lines 18-33, lines 49-61).

33. Regarding claim 5, Sparks disclosed a server comprising: organizing means for, based on personal information of participants of a plurality of terminals connected to a network, selecting the participants, who are compatible with one another, to organize the selected participants; and information sharing means for interconnecting the terminals of the organized participants to share information (Abstract, Figures 5A-6B, 12, column 5 lines 5-25, column 6 lines 18-33, column 7 lines 22-34).

34. Regarding claim 6, Sparks disclosed a server wherein said participants organized by the organizing means are supplied as they are to said information sharing means (Abstract, column 5 lines 5-26, column 6 lines 18-33, column 6 line 62-column 7 line 3).

35. Regarding claim 7, Sparks disclosed a server wherein said server transmits control information for carrying out a specific task to the terminals of the participants organized by the organizing means (Abstract, column 5 lines 5-26, column 6 lines 18-33, column 6 line 62-column 7 line 3).

36. Regarding claim 8, Sparks disclosed a server wherein said specific task is a task for starting a program to be carried out on said plurality of terminals from an intervening stage of the

program (Abstract, column 2 lines 16-45, column 4 line 51-column 5 line 6, column 16 lines 1-21, column 17 lines 8-22).

37. Regarding claim 9, Sparks disclosed a server wherein said program is an online game, and said intervening stage is one of stages of the online game (column 1 lines 37-49, column 6 lines 18-33, lines 49-61).

38. Regarding claim 10 and 11, a database server for storing personal information (Figure 4, column 4 lines 4-14). Examiner takes Official Notice (see MPEP § 2144.03) that "an external memory means" in a computer networking environment was well known in the art at the time the invention was made. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03. However, MPEP § 2144.03 further states "See also *In re Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, *In re Boon*, 169 USPQ 231, 234 states "as we held in *Ahlert*, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

39. Regarding claim 12, Sparks disclosed a terminal device for a network system in which a plurality of the terminal devices are connected to a server, said terminal device transmitting personal information of a user to the server; sharing information through the server among the

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rest terminal devices organized by the server; and cooperating with the rest terminal devices to carry out a specific task (Abstract, Figures 5A-6B, 12, column 5 lines 5-25, column 6 lines 18-33, column 7 lines 22-34).

40. Regarding claim 13, Sparks disclosed a terminal device wherein said specific task is a task for starting a program to be carried out by said plurality of the terminal devices from an intervening stage of the program (column 1 lines 37-49, column 6 lines 18-33, lines 49-61).

41. Regarding claim 14, Sparks disclosed a terminal device wherein said program is an online game, and said intervening stage is one of stages of the online game (column 1 lines 37-49, column 6 lines 18-33, lines 49-61).

42. Regarding claim 15, Sparks disclosed a task carrying out method in which terminal devices connected to a server, comprising the steps of: transmitting personal information of the users of the terminal devices to the server; sharing information through the server among the rest terminal devices organized by the server; and cooperating with the rest terminal devices to carry out a specific task (Abstract, Figures 5A-6B, 12, column 5 lines 5-25, column 6 lines 18-33, column 7 lines 22-34).

43. Regarding claim 16 and 18, Sparks disclosed a computer readable medium storing a program for a server comprising the steps of: searching personal information of the participants of a plurality of terminals connected to a network; selecting the participants, who are compatible with one another, based on the personal information of the participants; sharing information among the terminals of the organized participants; and transmitting control information for carrying out a specific task (Abstract, Figures 5A-6B, 12, column 5 lines 5-25, column 6 lines 18-33, column 7 lines 22-34).

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44. Regarding claim 17 and 19, Sparks disclosed a computer readable medium storing a program for a terminal device comprising the steps of: transmitting to a server personal information of users; sharing information through the server among the rest terminal devices organized by the server; and cooperating with the rest terminal devices to carry out a specific task (Abstract, Figures 5A-6B, 12, column 5 lines 5-25, column 6 lines 18-33, column 7 lines 22-34).

45. Since all the limitations of the claimed invention were disclosed by Sparks, claims 1-19 are rejected.

Conclusion

46. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to the enclosed PTO-892 for details.

47. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tam (Jenny) Phan whose telephone number is (703) 305-4665. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Cuchlinski can be reached on 703-308-3873. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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